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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,564	10/02/2003	John Timothy Sims		9284

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EXAMINER	
PARSLEY, DAVID J	

ART UNIT	PAPER NUMBER
3643	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/677,564	SIMS, JOHN TIMOTHY	
	Examiner	Art Unit	
	David J Parsley	3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10-2-03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

Specification

1. The disclosure is objected to because of the following informalities: on page 17 below claim 20, the entire abstract should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "variety" in line 3 of these claims is indefinite in that it is unknown to what specific polymers the term "variety" is referring.

Claims 7-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are improper Markush claims in that the phrase "the group comprising" is used and the claims should state - -the group consisting of- -, see MPEP section 2173.05(h).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 13 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,953,934 to Visser.

Referring to claim 1, Visser discloses an attachable fish attractant slug capable of being attached to a fishing apparatus having a fishing line, line hardware, and a lure comprising, a body – at 10,14,16, having a leading extreme, a trailing extreme and an exterior surface – see figure 1, a center bore – at 18, running through the body from the leading extreme to the trailing extreme, wherein the exterior surface opens into a non-straight groove – at the curved groove 22, connecting the exterior surface to the center bore – see figure 1, wherein the body is formed of a water soluble substance containing fish attractant – see column 5, wherein the center bore is larger than the line hardware but smaller than the lure – see figure 1. The limitations of the attractant slug traveling along the fishing line and over the line hardware before coming to rest against the lure constitute functional language describing the claimed apparatus by function of its use and adds no structural features to the claimed apparatus and therefore these limitations have not been considered, see *In re Danly*, 263 F.2d 844, 847, 120 USPQ 28, 531 (CCPA 1959) and MPEP section 2114.

Referring to claim 13, Visser discloses the attractant is menhaden – see column 1 lines 63-67.

Referring to claim 19, Visser discloses a method for placing a fish attractant slug in close proximity to a lure, wherein the lure is attached to a fishing apparatus having a rod, a fishing line extending from the rod, line hardware and a lure, and wherein the lure is being trolled through the water comprising, providing a fish attractant slug – at 10, 14, 16, including a body – at 14,16, having a leading extreme, a trailing extreme and an exterior surface – see figure 1, a center bore – at 18, running through the body from the leading extreme to the trailing extreme – see figure 1, wherein the exterior surface opens into a non-straight groove – at 22, connecting the exterior surface to the center bore – see figure 1, wherein the body is formed of a water soluble material containing fish attractant – see columns 1-4, wherein the center bore is larger than the line hardware but smaller than the lure, so that the attractant slug can travel along the fishing line and over the line hardware before coming to rest against the lure – see figure 1, attaching the fish attractant slug to the fishing line through the non-straight groove and into the center bore and releasing the fish attractant slug, so that gravity pulls the fish attractant slug down into the water, where the fish attractant slug will be urged along the fishing line by hydrodynamic forces until it comes to rest against the lure – see for example figure 1 and columns 1-4.

Claims 1, 3, 6-7, 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by or U.S. Patent No. 4,890,411 to Buccilli et al.

Referring to claim 1, Buccilli et al. discloses an attachable fish attractant slug capable of being attached to a fishing apparatus having a fishing line, line hardware, and a lure comprising, a body – at 90, having a leading extreme, a trailing extreme and an exterior surface – see figures

11-12, a center bore – see figure 11, running through the body from the leading extreme to the trailing extreme, wherein the exterior surface opens into a non-straight groove – at 94,96 of Buccilli, connecting the exterior surface to the center bore – see figures 11-12, wherein the body is formed of a water soluble substance containing fish attractant – see column 4, wherein the center bore is larger than the line hardware but smaller than the lure – see figures 11-12. The limitations of the attractant slug traveling along the fishing line and over the line hardware before coming to rest against the lure constitute functional language describing the claimed apparatus by function of its use and adds no structural features to the claimed apparatus and therefore these limitations have not been considered, see *In re Danly*, 263 F.2d 844, 847, 120 USPQ 28, 531 (CCPA 1959) and MPEP section 2114.

Referring to claims 3 and 6 Buccilli et al. discloses the non-straight groove – at 94,96 is zigzag shaped or chevron-shaped – see figures 11-12.

Referring to claims 7, 9 and 12 Buccilli et al. discloses the water soluble substance is a soluble polymer – see column 1 lines 63-68.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Visser as applied to claims 1 and 19 above, and further in view of 2,599,973 to Bujaky.

Referring to claims 2 and 20, Visser does not disclose the non-straight groove is helical. Bujaky does disclose the non-straight groove – at 14, is helical – see figures 1-5. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Visser and add the helical groove of Bujaky, so as to allow for the device to be easily attached and removed from a fishing line.

Referring to claim 14, Visser as modified by Bujaky further discloses the attractant is menhaden – see column 1 lines 63-68 of Visser.

Claims 3, 6-7, 9, 12, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Visser as applied to claim 1 above, and further in view of Buccilli et al.

Referring to claims 3 and 6, Visser does not disclose the non-straight groove is zigzag shaped or chevron shaped. Buccilli et al. does disclose the non-straight groove – at 94,96 is zigzag shaped or chevron-shaped – see figures 11-12. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Visser and add the zigzag or chevron shaped groove of Buccilli et al., so as to allow for the device to be easily attached and removed from a fishing line.

Referring to claims 7, 9 and 12 Visser does not disclose the water soluble substance is a soluble polymer. Buccilli et al. does disclose the water-soluble substance is a soluble polymer – see column 1 lines 63-68 of Buccilli et al. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Visser and add the device made from a soluble polymer of Buccilli et al., so as to allow for the device to be durable and lightweight.

Referring to claims 15 and 18, Visser as modified by Buccilli et al. further disclose the attractant is menhaden – see column 1 lines 63-67 of Visser.

Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Visser as applied to claim 1 above, and further in view of U.S. Patent No. 5,388,368 to Lawrence.

Referring to claim 4, Visser does not disclose the non-straight groove is an S-curve. Lawrence does disclose the non-straight groove – at 5, 6, 6' or 13 is an S-curve – see figures 4-9. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Visser and add the S curve groove of Lawrence, so as to allow for the device to be easily attached and removed from a fishing line.

Referring to claim 16, Visser as modified by Lawrence further discloses the attractant is menhaden – see column 1 lines 63-68 of Visser.

Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Visser as applied to claim 1 above, and further in view of U.S. Patent No. 1,883,574 to Cleeland.

Referring to claim 5, Visser does not disclose the non-straight groove is crescent-shaped. Cleeland does disclose the non-straight groove – at 31-33, is crescent-shaped – see figure 2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Visser and add the crescent-shaped groove of Cleeland, so as to allow for the device to be easily attached and removed from a fishing line.

Referring to claim 17, Visser as modified by Cleeland further discloses the attractant is menhaden – see column 1 lines 63-68 of Visser.

Claims 14 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Visser or Buccilli as modified by either of Bujaky, Lawrence or Cleeland as applied to claims 2

and 4-5 above, and further in view of Visser. Visser further discloses the attractant is menhaden – see column 1 lines 63-68. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Visser or Buccilli as modified by either of Bujaky, Lawrence or Cleeland and add the attractant being menhaden of Visser, so as to make the device more attractive to fish.

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buccilli et al. as applied to claim 1 above, and further in view of 2,599,973 to Bujaky.

Referring to claim 2, Buccilli et al. does not disclose the non-straight groove is helical. Bujaky does disclose the non-straight groove – at 14, is helical – see figures 1-5. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Buccilli et al. and add the helical groove of Bujaky, so as to allow for the device to be easily attached and removed from a fishing line.

Referring to claim 8, Buccilli et al. as modified by Bujaky further discloses the water-soluble substance is a soluble polymer – see column 1 lines 63-68 of Buccilli et al.

Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buccilli et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,388,368 to Lawrence.

Referring to claim 4, Buccilli et al. does not disclose the non-straight groove is an S-curve. Lawrence does disclose the non-straight groove – at 5, 6, 6' or 13 is an S-curve – see figures 4-9. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Buccilli et al. and add the S curve groove of Lawrence, so as to allow for the device to be easily attached and removed from a fishing line.

Referring to claim 10, Buccilli et al. as modified by Lawrence further discloses the water-soluble substance is a soluble polymer – see column 1 lines 63-68 of Buccilli et al.

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buccilli et al. as applied to claim 1 above, and further in view of U.S. Patent No. 1,883,574 to Cleeland.

Referring to claim 5, Buccilli et al. does not disclose the non-straight groove is crescent-shaped. Cleeland does disclose the non-straight groove – at 31-33, is crescent-shaped – see figure 2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Buccilli et al. and add the crescent-shaped groove of Cleeland, so as to allow for the device to be easily attached and removed from a fishing line.

Referring to claim 10, Buccilli et al. as modified by Cleeland further discloses the water-soluble substance is a soluble polymer – see column 1 lines 63-68 of Buccilli et al.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buccilli as applied to claim 1 above, and further in view of Visser. Buccilli does not disclose the attractant is from a group consisting of menhaden. Visser does disclose the attractant is menhaden – see column 1 lines 63-67. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Buccilli and add the attractant being menhaden of Visser, so as to make the device more attractive to fish.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to fishing weights and weighted lures in general:

U.S. Pat. No. 1,193,912 to Maire – shows sinker with helical groove

U.S. Pat. No. 2,625,767 to Pokras – shows weight with groove

U.S. Pat. No. 2,731,755 to Ward – shows weight with groove

U.S. Pat. No. 2,756,532 to Trester – shows weight with groove

U.S. Pat. No. 3,733,734 to Hysaw – shows weight with groove

U.S. Pat. No. 3,908,298 to Strader – shows slug with bore

U.S. Pat. No. 3,914,895 to Mize – shows weight with groove

U.S. Pat. No. 4,054,004 to Schott – shows weight with groove

U.S. Pat. No. 4,145,833 to Ratte – shows weight with groove

U.S. Pat. No. 4,459,775 to Ratte – shows weight with groove

U.S. Pat. No. 4,615,136 to Bank – shows slug with bore and groove

U.S. Pat. No. 4,649,664 to Mahan – shows weight with groove

U.S. Pat. No. 4,777,757 to de marees van Swinderen – shows weight with groove

U.S. Pat. No. 5,090,151 to Salminen – shows weight with bore and groove

U.S. Pat. No. 5,129,175 to Pixton – shows weight with groove

U.S. Pat. No. 5,157,860 to Clark – shows weight with groove and bore

U.S. Pat. No. 5,239,770 to Kohus – shows weight with groove

U.S. Pat. No. 5,335,441 to Blackwell – shows weight with groove and bore

U.S. Pat. No. 5,305,534 to Lazich – shows weight with groove

U.S. Pat. No. 5,490,345 to Infinger – shows weight with groove

U.S. Pat. No. 5,784,828 to Thompson – shows weight with bore

U.S. Pat. No. 6,161,324 to Hugunin – shows attractant scent in slug

U.S. Pat. No. 6,327,808 to Zascavage – shows lure with bore and groove

U.S. Pat. No. D458,982 to Ratte – shows lure with bore and groove

6. Any inquiry concerning this communication from the examiner should be directed to David Parsley whose telephone number is (703) 306-0552. The examiner can normally be reached on Monday-Friday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574.

Peter M. Poon
Supervisory Patent Examiner
Technology Center 3600

4/16/04